

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Hyun-kwon CHUNG

Application No. 10/673,368

Group Art Unit: 2435

Confirmation No. 4342

Filed: September 30, 2003

Examiner: Ponnoreay Pich

For: NETWORK ACCESSIBLE APPARATUS, SECURITY METHOD USED BY THE
APPARATUS, AND INFORMATION STORAGE MEDIUM THAT IS REPRODUCIBLE BY
THE APPARATUS

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed October 24, 2008, having a shortened period for response set to expire on November 24, 2008, the following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR § 1.142

Applicants provisionally elect Group (Species) II, claims 12-14 and 50, in response to the preliminary restriction requirement set forth in the Office Action.

II. Applicants Traverse the Requirement

The Examiner has failed to show a serious burden on the Examiner if restriction were not required. A requirement for restriction is permissible if there is a patentable difference between the species as claimed and there would be a serious burden on the Examiner if restriction is not required. MPEP § 806.01(a). As set forth in MPEP § 808.02,

"[t]he examiner must show by appropriate explanation one of the following:

(A) Separate classification thereof: This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) A separate status in the art when they are classifiable together: Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) A different field of search: Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search."

The Examiner has failed to show a separate classification, a separate status in the art, or a different field of search. The Examiner has not identified separate classifications into which the different species fall. The Examiner has also failed to show that the different species have attained a separate status in the art; for example, the Examiner has cited no patents to show such separate status. Finally, the Examiner has not shown that the different species would require a separate field of search. For example, as discussed above, the Examiner has not shown any specific separate classifications for each of the species. The Examiner has also not identified any different search queries for each of the species, nor has the Examiner identified different electronic resources that would be required. Again, as above, the Examiner has failed to provide reasons or examples as to why there would be a serious burden on the Examiner if restriction is not required. The Examiner has not shown that classification is different, has not shown that the field of search is different, and has not shown a clear indication of separate future classification and field of search.

Indeed, the evidence of record shows that the burden on the Examiner would be small. The Examiner previously determined, in the Restriction Requirement mailed February 2, 2007, that claims 3-14 were classified in class 726, subclass 2. The only evidence of record therefore indicates that Species I and Species II are in the same class and subclass. The Examiner has not presented any evidence showing otherwise. There is no burden on the Examiner if searching the different species requires searching the same class and subclass, since the searches would therefore overlap. See MPEP § 808.02 ("Where... the classification is the same... no reasons exist for dividing among independent or related inventions.") The Examiner has not shown that the amendments to the claims require searching a class or subclass other

than those already searched.

The Examiner previously determined that the subject matter of what is now deemed Species I and Species II did not constitute a serious burden on the Examiner. The Examiner has provided no reason why this is no longer the case. This is not a case where none of the limitations have been searched before, or where new claims have been added during prosecution. The Examiner has already conducted an extensive search of these claims, as indicated in the Examiner's search report. The only burden on the Examiner is to update his previous search based on the amendments to the claims.

The burden on the Examiner to update his search is small. For example, claim 3 was amended to incorporate the limitations of claim 14. All of the limitations of claim 3, therefore, have already been searched by the Examiner. The Examiner would not need to conduct an entirely new search. The Examiner has not shown how updating his previous search would be a serious burden. With respect to claim 12, the Examiner has not shown how updating his search to incorporate the amendments would be a significant burden. For example, S81 in the Examiner's search report, "(reliable or trust\$2 with syntax) and @ad<20020930" only returned fifty-seven results, and there is no indication that updating this search to include the amended limitations would significantly increase the number of references to be considered. Reviewing fifty-seven results is not a serious burden, especially given that many of those results were previously reviewed. The evidence therefore shows that there is no serious burden on the Examiner in searching Species II.

There would be no serious burden on the Examiner in searching Species I in addition to Species II. Claim 3 recites, in part "wherein the identifying of whether the context is a reliable context of an unreliable context comprises identifying the context as a reliable context if the command includes an "http://" request, and identifying the context as an unreliable context if the command includes an "httpu://" request." Search #S12 in the Examiner's search report, "httpu with (restrict\$3 or unreliable or forbidden)", corresponds to this limitation. As shown in the search report, search S12 only returned two (2) results. There is no serious burden on the Examiner to review two additional references, and there is no indication that an updated search along these lines would return so many new results as to pose such a serious. The evidence of record therefore shows that there is no serious burden on searching Species I in addition to Species II. The Examiner has provided no new evidence to the contrary.

III. Conclusion

The Examiner has not shown that the subject matter of the claims as amended falls into a different class or subclass, has not shown that the claims as amended have attained separate status in the art, and has not shown a separate field of search. Accordingly, as indicated in MPEP § 808.02, no reasons exist for separating the species identified by the Examiner, and the restriction requirement should be withdrawn.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 503333.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

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